

ESTTA Tracking number: **ESTTA124843**

Filing date: **02/13/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92041307
Party	Plaintiff Qiagen GmbH
Correspondence Address	Lorraine Linford Seed Intellectual Property Law Group PLLC 701 Fifth Avenue Ste 6300 Seattle, WA 98104-7092
Submission	Motion to Compel Discovery
Filer's Name	Lorraine Linford
Filer's e-mail	Lorrainel@SeedIP.com, Litcal@SeedIP.com
Signature	/Lorraine Linford/
Date	02/13/2007
Attachments	SP-MotionCompel.pdf (5 pages)(154992 bytes)

This motion to compel is supported by the Declaration of Lorraine Linford submitted concurrently herewith.

I. FACTUAL BACKGROUND

Petitioner QIAGEN filed its Petition to Cancel in this matter on October 2, 2002.

On July 14, 2003, QIAGEN served on Respondent Bio-Rad, by first-class mail, Petitioner's First Set of Requests for Production of Documents to Respondent and Petitioner's First Set of Interrogatories to Respondent (Declaration of Lorraine Linford ("Linford Decl."), ¶ 1; Exhs. 1-2).

Responses to these discovery requests were initially due on August 18, 2003 and extended 60 days, to October 17, 2003, by agreement of counsel. The proceeding was thereafter suspended by agreement of counsel for an aggregate period of approximately two years to allow the parties to negotiate a settlement. The parties eventually reached an agreement in principle. The terms were set out in a March 20, 2006 letter from QIAGEN's counsel to counsel for Bio-Rad (Linford Decl., ¶ 3).

In November, 2006, QIAGEN's counsel advised counsel for Bio-Rad that if QIAGEN did not receive Bio-Rad's response to the March 20 settlement letter by November 17, 2006, QIAGEN required Bio-Rad to respond to QIAGEN's outstanding discovery requests by no later than December 15, 2006 (Linford Decl., ¶ 4, Exh. 3). Bio-Rad responded with a counterproposal that QIAGEN rejected. In view of the rejection of the counterproposal, QIAGEN requested that Bio-Rad respond to the discovery requests by no later than January 16, 2007 (Linford Decl., ¶ 5, Exh. 4)

The parties' attorneys have continued to correspond regarding settlement and appear to have reached agreement on all the terms of a written settlement agreement, but an agreement has not been signed. On February 9, 2007, Petitioner's counsel advised Respondent's counsel by email that QIAGEN's testimony period would open February 15, 2007 and that QIAGEN would be filing a motion to compel Bio-Rad's responses to QIAGEN's outstanding written discovery pending signature of the agreement (Linford Decl., ¶¶ 6-8, Exh. 5).

In the event the settlement is not finalized, QIAGEN will need to go forward with the trial phase of the proceeding and needs the discovery sought from Bio-Rad, which includes

information and documents relating to Bio-Rad's adoption and use of the subject MDX mark, third-party use of the mark or term "MDX," and Bio-Rad's defense to QIAGEN's allegations (Linford Decl. ¶¶ 2, 9)

QIAGEN is entitled to full and complete responses to its discovery requests. QIAGEN has repeatedly requested Bio-Rad's responses to these written discovery requests by telephone and written correspondence, but to no avail.

QIAGEN now moves the Board for an Order compelling Bio-Rad to produce the requested written responses and documents and things.

II. THE BOARD SHOULD ORDER RESPONDENT TO
PRODUCE COMPLETE RESPONSES TO PETITIONER'S
INTERROGATORIES AND DOCUMENT REQUESTS

Pursuant to 35 C.F.R. § 2.120(e), Petitioner may move the Board to compel responses to its interrogatories and the production of documents which have been requested in discovery and have not been produced by the responding party. *See MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 U.S.P.Q. 952, 953 (TTAB 1979). Here, Respondent was properly served with interrogatories and document requests under 37 C.F.R. § 2.120 and Fed. R. Civ. P. 33 and 34.

QIAGEN has made a good-faith effort to obtain QIAGEN's discovery responses through the written and telephone communications described in the Linford Declaration, but Bio-Rad has not produced the requested responses and documents, which constitute evidence needed by QIAGEN in order to properly prepare its case in this proceeding.

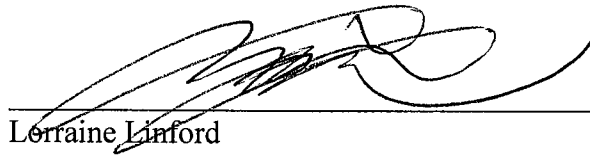
As shown in the Linford Declaration, the parties have been attempting to settle this case for over three years. However, there is no finalized, signed Settlement Agreement. Moreover, if the case does not settle, QIAGEN will need to proceed promptly with the trial phase of this proceeding and requires Bio-Rad's discovery responses to prepare for taking testimony, and has so advised Bio-Rad.

Accordingly, QIAGEN requests the Board to order Bio-Rad to make written responses to Petitioner's First Set of Interrogatories and Petitioner's First Set of Requests for Production of Documents, and to produce all documents and things in its possession, custody or control which are responsive to Petitioner's First Set of Requests for Production of Documents.

DATED this 13th day of February, 2007.

Respectfully submitted,

SEED IP Law Group PLLC

A handwritten signature in black ink, appearing to read 'Lorraine Linford', is written over a horizontal line.

Lorraine Linford
701 Fifth Avenue, Suite 5400
Seattle, Washington 98104
Phone: (206) 622-4900
Fax: (206) 682-6031

Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on this 13th day of February, 2006, the foregoing **PETITIONER'S MOTION TO COMPEL RESPONSES TO WRITTEN DISCOVERY REQUESTS** was served upon the Petitioner's counsel of record by United States first-class mail, postage prepaid, addressed as follows:

Bruce W. Schwab, Esq.
TOWNSEND AND TOWNSEND AND CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834



Annette Baca